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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,630	01/31/2006	Noriyuki Sakoh	277513US6PCT	7218
22850 7590 08/06/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER JACOB, AJITH	
			ART UNIT 2169	PAPER NUMBER
			NOTIFICATION DATE 08/06/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/566,630	<b>Applicant(s)</b> SAKOH ET AL.	
	<b>Examiner</b> Ajith Jacob	<b>Art Unit</b> 2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/06, 5/06</u> | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The instant application having Application No. 10/566630 has a total of 6 claims pending in the application, there are 3 independent claims and 3 dependent claims, all of which are ready for examination by the examiner.

### *Oath/Declaration*

2. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in **37 C.F.R. 1.63**.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4 and 6 are directed towards software, *per se*. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the

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descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

4. Claim 1 is a device claim that describes a control device for a display, but does not specify a physical piece of hardware to fulfill the claim, and thus has been rejected.

5. Claims 2-4 does not solve any of the non-statutory deficiencies of claim 1, and thus are rejected for the reasons stated above.

6. Claim 6 is a program claim that describes a program to control a display, but does not specify the storage of the program in a physical storage medium or device, and thus has been rejected.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Odamura et al. (GB 2,360,912 A).

For claim 1, Odamura et al. teaches:

A data display control device comprising: a database storing a plurality of data with at least a first size [base station receiving multiple data, page 10, lines 13-19]; search means for searching the database for at least one piece of data with the first size, based on an input search key [client terminal receiving request and transmitting to base station, page 10, lines 26-28]; and control means for controlling to obtain partial data with second size that is smaller than the first size and corresponding to a size of a display, out of the at least one piece of data found by the search means, from the database, and to display the partial data on the display [base station divides data into a range that fits the display, page 10, lines 13-19].

For claim 2, Odamura et al. teaches:

The data display control device according to claim 1, further comprising instruction means for issuing an instruction for scroll display of the partial data being displayed on the display, wherein the control means controls to obtain remaining data other than the partial data from the database and to perform the scroll display on the display, in response to the instruction [receive first page of data to display and sending the next pages to the display upon request, page 12, lines 4-21].

For claim 3, Odamura et al. teaches:

The data display control device according to claim 1, wherein the control

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means controls to obtain a data part, that is larger than the second size and smaller than the first size, out of the at least one piece of data found by the search means, with the data part added to the partial data, from the database, and to perform scroll display on the display [displaying edited second and later pages upon request to the display after the first page is transmitted, page 11, line 29 – page 12, lines 1-3].

Claim 5 is a method of claim 1. Odamura et al. teaches the limitations of claim 1 for the reasons stated above.

Claim 6 is a program of claim 1. Odamura et al. teaches the limitations of claim 1 for the reasons stated above.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of

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35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Odamura et al. as set forth above against claim 3 above, and in view of Negishi et al. (US 6,504,089 B1).

As per claim 1, Odamura et al. teaches control means displaying data in accordance with the size [page 10, lines 13-19], but does not teach the temporary storage of data in a storage medium before partial display of the data.

Negishi et al. teaches the data of a music piece being stored, and the at least one candidate of the piece information being presented [column 3, lines 51-59].

Odamura et al. (GB 2,360,912 A) and Negishi et al. (US 6,504,089 B1) are analogous art because they are from the same field of endeavor of displaying stored data.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the control unit for display described by Odamura et al. and add a storage unit for temporary storage and partial display as described by Negishi et al.

The motivation for doing so would have been to separate the "essential valuable content" [column 2, line 47] from a stored data to be displayed.

Therefore, it would have been obvious to combine Odamura et al. (GB 2,360,912 A) with Negishi et al. (US 6,504,089 B1) for the benefit of efficiently displaying partial information from stored data.

### ***Conclusion***

The Examiner requests, in response to this Office action, that support be shown for language added to any original claims on amendment and any new claims. That is, indicate support for newly added claim language by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s).

This will assist the Examiner in prosecuting the application.

When responding to this Office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajith Jacob whose telephone number is 571-270-1763. The examiner can normally be reached on M-F 7:30-5:00 EST, Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ali can be reached on 571-272-4105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

7/31/2007

AJ

KBP

AJ

Patent Examiner

  
MOHAMMAD ALI  
PRIMARY EXAMINER